

SUBMISSION

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4**Remarks**

Claims 486-538, 541-560, 563-576, 579-582, 585-592, 595-612, 615-618 and 621-630 are presently pending in the subject application. Claims 539, 540, 577, 578, 583, 584, 593, 594, 613, 614, 619 and 620 have been canceled herein without prejudice to the prosecution of the subject matter of these claims in this or a future continuing application.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Claims 486-491 have been amended herein to further recite, in the Markush groupings of those claims, limitations appearing in dependent claims 494, 495, 500-503, 506-509, 514-517, 533-546, 549-560, 565-582, 585-588, 591, 592, 595-600, 605-610, 613-618 and 621-630.

The target region of claims 555 and 556 has been amended herein consistent with *Neisseria* or *Escherichia* being the genus of the target and non-target species.

The claims are further amended herein to make non-substantive editorial changes, to correct claim dependencies based on claim cancellations and amendments to the independent claims, and to address the Examiner's several rejections in the manner described below.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 486, 487, 512, 513, 528 and 529 stand rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants submit that this rejection has been rendered moot by amendments to claims 486 and 487 herein. Specifically, reference to target regions corresponding to either bases 975-1060 or 1255-1290 of *E. coli* 16S rRNA or the encoding DNA have been deleted. Additionally, the proviso language of claims 486 and 487 has been deleted consistent with these amendments. Accordingly, withdrawal of the rejections on written description grounds is hereby respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 508, 509, 512, 513, 528 and 529 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this rejection, the Examiner

SUBMISSION

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4

argues that these claims depend, either directly or indirectly, from claims which recite overlapping but not identical base ranges. In response, Applicants have amended the independent claims to include in the Markush groupings target regions recited in claims 508, 509, 512 and 513. Further, the rejection of claims 528 and 529 has been rendered moot by Applicants amendments to claims 486 and 487 herein, in which the proviso language has been deleted. Accordingly, Applicants submit that the claims are definite and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 488, 489, 508, 509, 512 and 513 stand rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Stanbridge *et al.* (U.S. Patent No. 5,851,767). In support of this rejection, the Examiner contends that these claims recite a target region (*i.e.*, a location corresponding to bases 1255-1290 of *E. coli* 16S rRNA or the encoding DNA) which contains a base section of 16S rRNA disclosed by Stanbridge as forming the basis for a mycoplasma probe without introducing any limitation on what is detected, as in claims 486 and 487. Applicants note, however, that claims 488 and 489 and their dependents require that the recited hybridization assay means or oligonucleotide probe distinguish between nucleic acid of at least one target species and nucleic acid of at least one non-target species belonging to the same genus as the target species. Since Stanbridge merely discloses 16S rRNA gene fragments that differ from the 16S rRNA gene of *E. coli*, and nowhere discloses or suggests that these fragments might be used to distinguish between species of mycoplasma, Applicants submit that the claims are patentable in view of Stanbridge. *See* Stanbridge at column 2, lines 15-30 ("These fragments . . . form the basis mycoplasma-specific probes . . ."). Accordingly, withdrawal of this prior art rejection is respectfully requested.

Claim Objections

Claims 492-507, 510, 511, 514-527, 530-560 and 563-592 stand objected to by the Examiner as being dependent upon a rejected base claim. Because Applicants believe that the indicated claims should be allowable for the reasons set forth above, Applicants respectfully decline

SUBMISSION

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4

the Examiner's invitation to rewrite the objected to claims in independent form, including all of the limitations of the base claim and any intervening claims, at this time.

Allowed Claims

Applicants note with appreciation that claims 490, 491 and 593-630 are allowed.

Conclusion

Applicants submit that the subject application is in condition for allowance and early notice to that effect is earnestly solicited.

Please charge any fees due in connection with this Submission to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

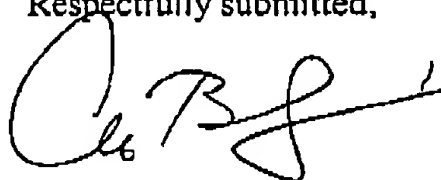
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I hereby certify that this correspondence (and any referred to as attached or enclosed) is being sent by facsimile to 571-273-8300 on the date indicated below to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

Date: December 9, 2005

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